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FRANK J CATALANO			GETZOW, SCOTT M	
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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* KELLY W. BUCHNER

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Appeal 2009-007963  
Application 10/840,064  
Technology Center 3700

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Decided: June 21, 2010

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Before JENNIFER D. BAHR, STEVEN D.A. McCARTHY, and  
STEFAN STAICOVICI, *Administrative Patent Judges*.

STAICOVICI, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF THE CASE

Kelly W. Buchner (Appellant) appeals under 35 U.S.C. § 134 (2006) from the Examiner's decision finally rejecting claims 1 and 5. Claims 2-4 and 6-8 are objected to by the Examiner as being dependent upon a rejected base claim and otherwise indicated as being allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim. Claims 9-11 have been allowed by the Examiner. We have jurisdiction over this appeal under 35 U.S.C. § 6 (2006).

## THE INVENTION

Appellant's invention relates to a procedure for treatment of human and animal tissues by stimulating deep layered muscle contractions in the tissue. Spec. 1, ll. 6-8.

Claim 1 is representative of the claimed invention and reads as follows:

1. A procedure for [therapeutic] treatment of human and animal tissues surrounding articular joints evidencing symptoms of fibromyalgia comprising the steps of:
  - identifying an articular joint evidencing symptoms of fibromyalgia;
  - sandwiching the tissue surrounding the identified articular joint between one or more pairs of opposed emitter pads in contact with the skin; and
  - applying a biphasic [faradic] pulse sequence to the pairs of emitter pads to stimulate deep layered muscle contractions in the sandwiched tissue.

## THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Grey                    US 5,397,338                    Mar. 14, 1995

Appellant seeks review of the Examiner's rejection of claims 1 and 5 under 35 U.S.C. § 103(a) as unpatentable over Grey.

## SUMMARY OF DECISION

We REVERSE.

## OPINION

Appellant argues that Grey does not disclose stimulating deep layered muscle contractions, as required by independent claim 1. Br. 7. In response, the Examiner first points to column 1, lines 32-35 of Grey to show that Grey discloses adjusting the pulse amplitude, pulse width, and pulse rate depending on user preferences. The Examiner then opines that an

. . . electrical current strong enough to promote healing of tissue such as tendon, muscle and bone, as taught in Grey, would be enough to provide for deep layered muscle contractions in the typical patient.

Ans. 4-5.

In view of the above findings, the Examiner then concludes that the Grey device is "considered to be able to stimulate deep layered muscle contractions." Ans. 3.

At the outset, it appears that the Examiner is relying on a theory of inherency to establish that the electrical current of Grey's device is capable of stimulating deep layered muscle contractions. In relying upon the theory

of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). In this case, the question raised is whether the electrical current of Grey is *necessarily* capable of stimulating deep layered muscle contractions.

While the Examiner correctly points out that the device of Grey can adjust the pulse amplitude, pulse width, and pulse rate of the electrical signal delivered, so as to promote healing and aid in pain relief, this in no way demonstrates that the electrical current of Grey's device is capable of stimulating deep layered muscle contractions, as the Examiner contends.

*See* Grey, col. 1, ll. 8-11. In other words, just because the pulse amplitude, pulse width, and pulse rate of the electrical current of Grey's device can promote healing of tissue it does not necessarily mean that it can also stimulate deep layered muscle contractions. For example, Grey discloses that adjustment of pulse amplitude, pulse width, and pulse rate of the delivered electrical signal is performed in order to avoid accommodation of the excitable tissue to stimulation. Grey, col. 9, ll. 9-11. Hence, although Grey discloses adjustment of the pulse amplitude, pulse width, and pulse rate, the resulting electrical current does not necessarily stimulate deep layered muscle contractions, as the Examiner opines. Therefore, the Examiner's finding that the electrical current of Grey's device is strong enough to provide for deep layered muscle contractions is mere speculation and conjecture based on an unfounded assumption that adjustments of the pulse amplitude, pulse width, and pulse rate of the delivered electrical signal

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would necessarily generate an electrical current strong enough to stimulate deep layered muscle contractions.

Since speculation and conjecture cannot form the basis for concluding obviousness, the rejection of independent claim 1 and dependent claim 5 under 35 U.S.C. § 103(a) as unpatentable over Grey cannot be sustained. *See In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988) (If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim dependent therefrom is nonobvious).

## DECISION

The Examiner's decision to reject claims 1 and 5 is reversed.

REVERSED

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